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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKASHI OHIRA

Appeal 2008-4455
Application 10/662,330
Technology Center 1700

Oral Hearing Held: Thursday, November 6, 2008

Before TERRY J. OWENS, PETER F. KRATZ, and
KAREN M. HASTINGS, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

HUI CHEN WAUTERS, ESQ.
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The above-entitled matter came on for hearing on Thursday, November 6, 2008, commencing at 1:35 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Jennifer M. O'Connor, Notary Public.

THE CLERK: Calendar number 27, Mrs. Wauters.

MS. WAUTERS: May I go ahead? Good afternoon, my name is Hui Wauters. I represent Appellant. I assume you're familiar with this case, so I'm going straight to the issues.

Claims one and three through six were rejected based on the combination of four references. The primary reference, *Crast*, teaches UV-curable coating to be used on golf balls and *Crast* just broadly teaches that primer or base coat may be used between the top coat and the cover of the ball. So *Crast* does not teach the claimed primer composition comprising an aqueous resin having UV-curable function grooves and the crosslinker.

Further, *Crast* does not teach that the primer composition there is not irradiated with UV radiation prior to applying your top coat. Still further, *Crast* does not teach cure the primer layer and the UV-curable paint at the same time. So the Examiner relies on *Jin* as teaching a primer composition as claimed in the present claim one. However, *Jin* teaches -- however *Jin* just identifies UV-curable coating as a top coat, so *Jin* does not teach the use of its curable coating as a primer.

The teachings of *Crast* and *Jin* do not provide reasonable expectation of success that the coating of *Jin* could be used as a primer in *Crast,* and there's no teaching in either *Crast* or *Jin* of what the adhesion interface might be like between the UV-curable coating of *Jin* and the UV-curable coating of *Crast.*

Secondly, *Jin* clearly states that the advantageous effects and benefits of its invention are tied to the coating being nearly 100 percent solid system. *Jin* also criticizes water-born coating being -- suffering from drawback of long curing time. That is, even if you combine *Crast* and *Jin* in the manner proposed by the Examiner, it wouldn't lead to the aqueous resin containing primer composition of claim one because *Jin* does not teach its coating can be formulated as a water-based composition.

Since *Jin* expressly states its coating composition to be nearly 100 percent solid system, one wouldn't look to the third reference, *Lokai*, to -- which teaches using aqueous radiation curable binder dispersions to reduce the amount of reactive diluents. Reformulating *Jin's* solvent-free coating as a water-based composition would be completely contrary to *Jin's* teachings.

In the fourth reference, *Nealon*, the Examiner cites it as teaching cure both the primer and the top coat at same time. However, *Nealon* does not mention UV radiation. The curing in *Nealon* is strictly thermal curing. Further, *Nealon* teaches that the primer was heat dried and cured for 10 minutes in a curing oven and then apply the top coat. Cure the primer and top coat at the same time for six hours.

But in the present claim one, it recites that the primer was not irradiated before the -- before top coat is coated, which means the primer was not cured. *Nealon* teaches the primer was dried and cured for 10 minutes, so *Nealon's* teachings teach away from the presently claimed invention.

JUDGE KRATZ: The last reference you were talking about, *Nealon*, while they do teach that you can have this preliminary curing , partial curing going on in the primary layer, and then the simultaneous

curing of the primary layer with the top layer, that initial curing is not a UV-curing; it's a heat curing. And your claims don't prevent or don't eliminate the possibility of a heat curing going on during -- of the primer layer, right? You could have a heat cure of the primary layer before you have the final curing of the -- UV-curing of the primary layer and the final coat together?

MS. WAUTERS: Since the composition of the present invention is UV-curable, so by heating, they are not cured. It says it's not cured. It's not irradiated by the UV radiation before applying the top coat, which means they are not cured. But *Nealon* teaches that their primer was cured, so it teaches away from what claim one recites.

JUDGE KRATZ: Is the -- are the coating compositions of *Nealon* different such that they would not be UV-curable?

MS. WAUTERS: I think they are not saying it's UV-curable, so they are different from what is claimed. Because the primer of claim one comprises resin having UV-curable functional group, also a crosslinker, while in the primer of *Nealon* it says just resin, there's no crosslinker in the composition.

JUDGE KRATZ: The method of application of the primary reference, *Crast*, and I guess the secondary reference, *Jin*, when they put on these primers and the final coat, are they ever the same coat, the same materials used?

MS. WAUTERS: You mean the top coat?

JUDGE KRATZ: Could the top coat and the primer coat be the same materials?

MS. WAUTERS: *Crast* does not teach you what the primer is and *Jin* does not teach using a primer. *Jin* only teaches top coating to be

used for the ball. So one wouldn't use coating of *Jin* as a primer of *Crast*. So by combining those references, the present invention wouldn't be arrived.

JUDGE KRATZ: Thank you. Any questions?

JUDGE OWENS: No more questions.

MS. WAUTERS: Okay, thank you. So I can go? I'm done?

JUDGE KRATZ: Yes.

MS. WAUTERS: Okay, thanks.

Whereupon, at 1:45 p.m., the proceedings were concluded.